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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,517	04/15/2004	James McGarry	061026-0373	8160
9629	7590	10/05/2006	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			CLEMENT, MICHELLE RENEE	
			ART UNIT	PAPER NUMBER
			3641	

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/825,517	MCGARRY, JAMES	
	Examiner	Art Unit	
	Michelle (Shelley) Clement	3641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 28-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-27 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
2. Claim 1 recites the limitation "the indicating element" in line 6. There is insufficient antecedent basis for this limitation in the claim.
3. The claims recite the limitation "the element". There is insufficient antecedent basis for this limitation in the claim in that both a "movable element" and an "indicating element" have previously been set forth and it is not clear which one of these or if either one of these is intended as the referenced "the element".
4. Claim 9 recites the limitation "the loaded-chamber-indication position" in line 3. There is insufficient antecedent basis for this limitation in the claim.
5. Claim 10 recites the limitation "the top" in line 1. There is insufficient antecedent basis for this limitation in the claim.
6. Claim 15 recites the limitation "the rear end" in line 6. There is insufficient antecedent basis for this limitation in the claim.
7. Claim 16 recites the limitation "the top" in line 1. There is insufficient antecedent basis for this limitation in the claim.
8. Claim 17 recites the limitation "the loaded-chamber-indication position" in line 2. There is insufficient antecedent basis for this limitation in the claim.

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9. Claim 19 recites the limitation "the element" in line 2. There is insufficient antecedent basis for this limitation in the claim in that it is not clear if this is a different structure than the previously recited "indicating element".

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-4, 9, 14, 15, 20 and 21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by da Silveira (US Patent # 6,256,915). Da Silveira discloses a loaded chamber indicator for pistols comprising a housing comprising a reciprocating slide, having an external surface and defining a chamber to receive a cartridge, the housing defining a fulcrum and a movable element having a first end, a second end, and a center equally-spaced therebetween, an indicating element pivotally engaged with the fulcrum between the center and one of the ends, wherein the indicating element is positioned in the housing, at a rear end of the slide, to contact the cartridge and is movable to a position in which the element protrudes outwards from the external surface of the housing to provide a user of the pistol with a visual and tactile indication that the cartridge is loaded in the chamber. Wherein the element does not protrude outwards from the external surface of the housing to a second position in which the element protrudes outwards from the external surface of the housing. Wherein the element is positioned generally behind the chamber and the first end is a front end and the second end is a rear end, the front end located closer to the chamber than the rear end, wherein the element is pivotally engaged with

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the fulcrum at the rear end. Wherein the entire element between the fulcrum and the front end is movable from the first position to the second position. Wherein the pistol comprises an external surface and at least a portion of the element protrudes outwards from the external surface of the pistol in a loaded-chamber-indication position to provide a user of the pistol with a visual and tactile indication that a cartridge is in a loaded position. The element is a bar-shaped lever, the second end and the mid-portion are both unconstrained and displaceable in relation to the housing. The element comprises a forward sloping surface on the first end to make smooth initial contact with the cartridge. A spring acts against the lever and biases the lever towards the unloaded-chamber-indication position.

12. Claims 1-3, 5, 7 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Jolidon (US Patent # 1,896,820). Jolidon discloses a loaded chamber indicator for pistols comprising a housing comprising a reciprocating slide, having an external surface and defining a chamber to receive a cartridge, the housing defining a fulcrum and a movable element having a first end, a second end, and a center equally-spaced therebetween, an indicating element pivotally engaged with the fulcrum between the center and one of the ends, wherein the indicating element is positioned in the housing, at a rear end of the slide, to contact the cartridge and is movable to a position in which the element protrudes outwards from the external surface of the housing to provide a user of the pistol with a visual and tactile indication that the cartridge is loaded in the chamber. Wherein the element does not protrude outwards from the external surface of the housing to a second position in which the element protrudes outwards from the external surface of the housing. Wherein the element is positioned generally behind the chamber and the first end is a front end and the second end is a rear end, the front end located closer to the

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chamber than the rear end, wherein the element is pivotally engaged with the fulcrum at the rear end. Wherein the element is retained within the housing by a horizontal surface located adjacent to the second end which mates with a corresponding horizontal surface in the housing. The indicating element is pivotally engaged with the fulcrum with a pinless connection (See examiner's notes on Figure 18). The mid-portion and front end are displaceable to a loaded-chamber-indication position. The rear end of the indicating element is restrained in the slide without a pinned connection by two opposing horizontal surfaces arranged to contact each other, one of the horizontal surfaces disposed on the indicating element and the other horizontal surface disposed in the slide. The cartridge has a rim, which holds the element in the loaded-chamber indication position.

13. Claims 1-5, 9-21 and 24-26 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Luger (as shown in Small Arms of The World pages 113-117). Luger discloses a loaded chamber indicator for pistols comprising a housing comprising a reciprocating slide, having an external surface and defining a chamber to receive a cartridge, the housing defining a fulcrum and a movable element having a first end, a second end, and a center equally-spaced therebetween, an indicating element pivotally engaged with the fulcrum between the center and one of the ends, wherein the indicating element is positioned in the housing, at a rear end of the slide, to contact the cartridge and is movable to a position in which the element protrudes outwards from the external surface of the housing to provide a user of the pistol with a visual and tactile indication that the cartridge is loaded in the chamber. Wherein the element does not protrude outwards from the external surface of the housing to a second position in which the element protrudes outwards from the external surface of the housing. Wherein the

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element is positioned generally behind the chamber and the first end is a front end and the second end is a rear end, the front end located closer to the chamber than the rear end, wherein the element is pivotally engaged with the fulcrum at the rear end. Wherein the entire element between the fulcrum and the front end is movable from the first position to the second position. Wherein the pistol comprises an external surface and at least a portion of the element protrudes outwards from the external surface of the pistol in a loaded-chamber-indication position to provide a user of the pistol with a visual and tactile indication that a cartridge is in a loaded position. The element is a bar-shaped lever, the second end and the mid-portion are both unconstrained and displaceable in relation to the housing. The element is mounted in the top of the housing and is displaceable in an upward direction. The element is an elongated lever and the top of the housing comprises an elongated slot configured to pivotally receive the element. The pistol comprising a spring that acts against the lever and biases the lever towards the unloaded-chamber-indication position. The lever comprises a support base projecting downwards from a bottom surface of the lever which rests on the housing and the elongated slot contains a landing figured to receive the support base of the lever. The element comprises a forward sloping surface on the first end to make smooth initial contact with the cartridge. The rear end of the indicating element is restrained in the slide without a pinned connection by two opposing horizontal surfaces arranged to contact each other, one of the horizontal surfaces disposed on the indicating element and the other horizontal surface disposed in the slide. Indicia is provided on a side surface of the lever to communicate to a user that a cartridge is loaded in the chamber.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over da Silveira (US Patent # 6,256,915). Da Silveira discloses the claimed loaded chamber indicator but does not expressly disclose the particular elements of the pistol including the barrel movably disposed in the slide cavity, the firing pin and the hammer, da Silveira discloses the indicator for use with such a pistol. Since barrels, firing pins and hammers are standard elements in the pistol firearm shown in the figures of de Silveira, it would be obvious to one of ordinary skill in the art to include those elements with the device as taught by de Silveira. The suggestion/motivation for doing so would have been to obtain an operative firearm.

16. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jolidon as applied to claim 15 above, and further in view of Krag (US Patent # 1,028,032). Although Jolidon does not expressly disclose the element mounted in the top of the slide to be displaceable in an upward direction, Krag does. Krag teaches a loaded-chamber indicating element comprising an elongated indicating element that may be mounted in the tope of the slide in order that the element is more easily viewed by a shooter. Krag and Jolidon are analogous art because they are from the same field of endeavor: loaded-chamber indicators. Therefor, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the indicator located on the top of the slide and displaceable in an upward direction as suggested by

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Krag with the indicating device as disclosed by Jolidon. The suggestion/motivation for doing so would have been to obtain a loaded-chamber indicator that could be easily seen by a user.

17. Claims 7, 8, 22, 23 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luger as applied to claims 1, 20 and 24 above. Luger discloses the claimed invention except for the lever specifically expressly being at least 1.0 inches long and the indicia being at least .085 inches tall. Therefor, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the lever at least 1.0 inches long and the indicia at least 0.085 inches tall, since it has been held that discovering an optimum or workable size of a result effective variable involves only routine skill in the art and applicant has furthermore disclosed that these sizes are merely a matter of design choice.

Allowable Subject Matter

18. Claim 6 is objected to as being dependent upon a rejected base claim, but would possibly be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion


19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Felk (US Patent # 5,410,831), Luger (US Patent # 808,463), Hirsh (US Patent # 790,634), Skandera (US Patent # 2,100,273), Moczijdlower et al. (US Patent # 6,257,116), McGarry (US Patent Application # 2005/0229458), and Gussalli Beretta (US Patent # 6,966,137).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle (Shelley) Clement whose telephone number is 571.272.6884. The examiner can normally be reached on Monday thru Thursday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571.272.6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


MICHELLE CLEMENT
PRIMARY EXAMINER